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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,786

03/29/2004

Masamoto Ito

HGM-143-A

9485

21828

7590

03/21/2006

CARRIER BLACKMAN AND ASSOCIATES
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NOVI, MI 48375

EXAMINER

BOEHLER, ANNE MARIE M

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/811,786	ITO ET AL.	
	Examiner	Art Unit	
	Anne Marie M. Boehler	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/6/06.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 7, 8, 17, and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 6, 2006.
2. Applicant's election with traverse of the election in the reply filed on January 6, 2006 is acknowledged. The traversal is on the ground(s) that there is no significant burden on the examiner. This is not found persuasive because with an election of species, the examiner must establish that there is distinct structure. In the present case, the structure of the first embodiment is entirely different from that of the second embodiment and the two embodiments are claimed. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 1-6, 9-16, 19, and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a side cover structure, does not reasonably provide enablement for the side cover being contiguous with the rear wheel suspension. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicant's specification generally states that the side covers are contiguous with the rear wheel suspension. However, to be "contiguous" the structures must be touching or closely adjacent. That is not the case for applicant's invention as disclosed and claimed. Applicant's figure 2 clearly shows a significant gap (along main frame 17) between the side cover 27 and the rear suspension 41 (it appears that applicant's

numeral 41 corresponds to the location where the rear wheel suspension attaches to the vehicle frame. Normally, no part of the fixed vehicle frame would be considered part of the rear wheel suspension). Therefore, the side cover and suspension are not contiguous, as disclosed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 6, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kishi (USPN 4,678,223).

Kishi shows a motorcycle with a front mounted radiator 22, radiator cover 42, engine 21, and fuel tank 23. A side cover 45, on each side of the motorcycle, faces the outlet of the radiator and extends between and covers the space between the fuel tank and the engine to an area near the rear suspension 9.

6. Claims 1, 4, 6, 9-11, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohama (USPN 4,818,012).

Kohama shows a motorcycle with a front mounted radiator 10, radiator cover 20, engine 9, and fuel tank 16. A side cover 21, on each side of the motorcycle, faces the outlet of the radiator and extends between and covers the space between the fuel tank and the engine to an area near the rear suspension 5. The side covers, shown best in Figure 4, have a convex upper portion along wall 21b and concave lower portion 21c, as broadly recited.

7. Claims 1-6, 9-16, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kofuji (PGPub 2004/0036250)

In Figure 1, Kofuji shows a motorcycle with a front mounted radiator within radiator cover 41. A side cover (unnumbered) is also shown in Figure 1, behind the radiator cover 41 and between fuel tank 14 and engine 9. The side cover has a convex upper portion and a concave lower portion and a crest therebetween.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

8. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 2, 3, 5, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kishi.

Kishi shows the side cover enclosing a substantial portion of the engine, but is silent regarding an engine control or ignition unit. However, these elements are old and well known and normally required for proper operation of the engine. It would have been obvious to one of ordinary skill in the art to provide an ignition or engine control unit near the engine, below the side plate, in order to maintain engine components together.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JA 7-17449, JA 7-228,279, JA 8-142956, Katoh, Suzuki, Yamashita, and Sakuma each show side covers extending back from a radiator.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie M. Boehler whose telephone number is 571-272-6641. The examiner can normally be reached on 7:30-5:00, Monday-Thursday, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6612. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anne Marie M. Boehler
Primary Examiner
Art Unit 3611

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